

### REMARKS

Claims 9-11 are objected to as being improperly dependent. This objection is overcome in view of the amendments to claims 9 and 10.

Claims 1, 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bakoglu et al (U.S. 5,983,369). Claims 2, 4 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bakoglu in view of Osborn et al (U.S. 6,182,048). Claims 5, 6, 9, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Olarig et al (U.S. 6,032,257). Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Wallis et al (U.S. Pub. 2001/0051884). Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu in view of Rajagopalan (U.S. 6,934,686). Claims 12, 14, 16, 22-25 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan, and further in view of Wallis. Claims 13 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan and further in view of Olarig. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan and further in view of Wallis. These rejections are not applicable to the amended claims.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach detecting, by the computer system, a change in the configuration of the computer system; sending, by the computer system, a warranty upgrade request to a remote warranty processor when a change in the configuration of the computer system is detected, the warranty upgrade request including configuration information for the computer system; and paying a warranty upgrade fee to prompt release of further warranty information.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims as amended, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because they do not teach or suggest detecting, by the computer system, a change in the configuration of the computer system; sending, by the computer system, a warranty upgrade request to a remote warranty processor when a change in the configuration of the computer system is detected, the warranty upgrade request including configuration information for the computer system; and paying a warranty upgrade fee to prompt release of further warranty information.

Thus, none of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

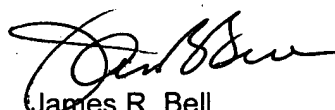
The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims as amended, and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of all of the above, the allowance of claims 1-25 and 29 is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

  
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